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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,947	12/26/2001	Hsuan-Yin Lan-Hargest	12938-003002	8464

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STEPTOE & JOHNSON LLP
1330 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

ZUCKER, PAUL A

ART UNIT	PAPER NUMBER
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1621

MAIL DATE	DELIVERY MODE
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12/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/025,947

Applicant(s)

LAN-HARGEST ET AL.

Examiner

Paul A. Zucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 August 2007 has been entered.

Current Status

2. This action is responsive to Applicants' amendment of 24 August 2007.
3. Receipt and entry of Applicants' amendment is acknowledged.
4. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 are pending.
5. The rejection under 35 USC § 102, set forth in paragraph 6 of the previous Office Action mailed 24 May 2007 is withdrawn in response to Applicant's amendment.
6. Claims 1-5, 7, 8, 22, 25, 26, 91-94, 96, 97, and 102 are rejected under 35 U.S.C. 102(b) as being anticipated by Herold et al (US 5,010,189 04-1991). Herold discloses (Column 30, lines 2-7) the compound 6-cyclohexyl-2-phenyl-4-hexenoic acid which is an instantly claimed compound wherein L is substituted with monocyclic aryl. Since no specific double bond geometry is disclosed the Examiner assumes that both isomers are present. Fleming further discloses (Column 29, lines 9-14) an aqueous solution of the compound corresponding to a pharmaceutical

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composition. Herold therefore anticipates claims 1-5, 7, 8, 22, 25, 26, 91-94, 96, 97, and 102.

Examiner's Response to Applicant's Response to This Rejection

7. Applicants present arguments. The Examiner responds below:

a. Applicants argue that Herold does not disclose the acid but rather the ester.

The Examiner disagrees, as indicated previously, since Herold discloses the ester's hydrolysis, after isolation, to the corresponding acid with 6N NaOH.

Further, Applicants have presented an amendment which does not overcome the rejection of record since the compound Herold's compound is still encompassed. The added proviso therefore does not apply to the compound of Herold.

b. Applicants further argue that in claims 1, 22, 80, 91, 102 and 103, L is a straight hydrocarbon chain optionally containing at least one double bond adjacent to Y¹ or Y². To this the Examiner responds:

i. The limitation Applicants' point to is optional and therefore not considered by the Examiner to be a required limitation;

ii. Y¹ may be CH₂ and the double bond is adjacent to the CH₂ group between it and the cyclohexyl ring which, in fact, meets the cited limitation, optional though it be.

The rejection is therefore MAINTAINED.

8. The rejection under 35 USC § 102, set forth in paragraph 11 of the previous Office Action mailed 24 May 2007 is withdrawn in response to Applicant's remarks.

9. The rejection under 35 USC § 102, set forth in paragraph 12 of the previous Office Action mailed 24 May 2007 is withdrawn in response to Applicant's amendment.

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New Rejections

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-5, 7, 8, 12, 13, 16, 17, 90-94, 96, 97 and 99-103 are rejected under 35 U.S.C. 102(b) as being anticipated by Colwell et al (Journal of Medicinal chemistry, 5,5-Diarylpenta-2,4-dienoic Acid Amides as Potential Antimalarial Agents, 1968, 11(4), pages 749-752). Colwell discloses (Page 750, top, Table 1, entries 14, 21, 32 and 35 , top) 5,5-diarylpenta-2,4-dienoic acids which correspond to instantly claimed compounds in which A is phenyl (unsubstituted or substituted with halo (Cl or F) or alkoxy), L is a C₄ all trans diene substituted with monocyclic aryl, Y₁,Y₂=a bond, X₁,X₂= O. No provisos apply. Colwell therefore anticipates claims 1-5, 12, 13, 22 1-5, 7, 8, 12, 13, 16, 17, 90-94, 96, 97 and 99-103.

Conclusion


11. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 are pending.
Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 are rejected.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Evonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Paul A. Zucker
Primary Examiner
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